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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,802	11/09/2001	Michael J. Seguin	5592.8	7862
21999	7590	06/28/2005	EXAMINER	
KIRTON AND MCCONKIE 1800 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE P O BOX 45120 SALT LAKE CITY, UT 84145-0120			ZURITA, JAMES H	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,802

Applicant(s)

SEGUIN, MICHAEL J.

Examiner

James H. Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Prosecution History

On 9 November 2001, applicant filed the instant application, claiming priority to provisional application 60/247446, which was filed on 30 November 2000.

On 9 September 2004, the Examiner rejected claims 1-20.

On 19 April 2005, applicant amended claims 1, 8, 13, 17, 19 and 20.

Response to Amendment

On 9 March 2005, applicant amended claims 1, 8, 13, 17, 19 and 20.

Claims 1-20 are pending and will be examined.

Response to Arguments

Applicant's arguments filed 19 April 2005 have been fully considered but they are not persuasive.

Claim Objections are withdrawn in view of amendments.

Rejections under 112 are maintained. Applicant's arguments, pages 8-9, are not persuasive. There is no mention of authorizing a purchase order in cited sections, and Fig. 3, blocks 80-82. Please also see rejection above.

Rejections under 101 are maintained. Please see additional explanation above.

Rejections under 103

In response to applicant's comments concerning various aspects of Shkedy and DeBusk, the fact that applicant has recognized another advantage which would flow

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naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that the references fail to show certain benefits or features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "convenience to a single buyer" no "single purchase order") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 17 is directed to determining whether the purchasing order is authorized. The disclosures refer to determining whether a user is authorized to access a portal. There is no description of how a portal would determine whether a purchase order is authorized:

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FIG. 3 illustrates a flow chart that provides a representative embodiment for accessing and otherwise using a dynamically customizable commerce portal for the purchasing of goods and/or services that are offered for sale by a variety of vendors. In FIG. 3, execution begins at step 80 where a user, or an agent thereof, accesses a single commerce portal. A determination is then made at decision block 82 as to ***whether or not the user is authorized for utilizing the commerce portal***. If it is determined that the user is not authorized to use the commerce portal, execution returns back to start. Otherwise, if it is determined at decision block 82 that the user is authorized to utilize the commerce portal, execution proceeds to step 84. paragraph 43, and disclosures, page 16, line 17-page 17, line 2, emphasis added.

Block 80 reads, "access single commerce portal" block 82 reads, "authorized?"

There is no mention of ***authorizing a purchase order***.

Claim Rejections - 35 USC § 101

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 13-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

1. [Technological Arts Analysis]

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow

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apply, involve, use, or advance the technological arts. The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Moreover, the courts have found that a claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer. See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). Finally, the Board of Patent Appeals and Interferences (BPAI) has recently affirmed a §101 rejection finding the claimed invention to be non-statutory based on a lack of technology. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

2. [Technology only in the preamble]

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Moreover, the courts have found that a claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer. See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). Finally, the Board of

Patent Appeals and Interferences (BPAI) has recently affirmed a §101 rejection finding the claimed invention to be non-statutory based on a lack of technology. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

In the present case, **Claims 13-18** are directed to a method and its steps. However, the technology mentioned in the preamble is involved only in a nominal way with the body of the claim. Some of the claims (15, 16, 17, 18) recite no technology at all.

3. [Nominal recitation of technology]

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts".

See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Moreover, the courts have found that a claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer. See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). Finally, the Board of Patent Appeals and Interferences (BPAI) has recently affirmed a §101 rejection finding the claimed invention to be non-statutory based on a lack of technology. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case, **Claims 13-18** are directed to a method and its steps. However, the technology mentioned in the preamble is involved only in a nominal way with the body of the claim. Some of the claims (15, 16, 17, 18) recite no technology at all.

4. [State Street Analysis]

Despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, the courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory

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subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998). Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Thus, in order for a claimed invention to be statutory, the claimed invention must produce a useful, concrete and tangible result.

["Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect.]

In the present case, **Claims 13-18** are directed to a method and its steps. However, the technology mentioned in the preamble is involved only in a nominal way with the body of the claim. Some of the claims (15, 16, 17, 18) recite no technology at all.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 5-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy (US 6,260,024).

As per claims 1, 13 and 19, Shkedy discloses systems, networks, methods and computer-executable code for procurement of multiple products offered for sale by a variety of vendors, including:

providing a gateway that includes a customizable selection of products offered for sale by a variety of vendors. See, for example, at least Fig. 1 and related text. See also references to Internet and gateways, at least Col. 8, line 55-Col. 92, line 2.

receiving a purchase order for products provided in the gateway that are to be purchased by a customer. See at least references to purchase orders, for example, Col. 2, lines 41-54.

distributing the purchase order to one or more vendors. See, for example, at least references to presenting purchase orders to several sellers, at least Col. 3, lines 1-5, Col. 4, lines 48-59.

monitoring information relating to purchasing of the products. See, for example, at least 14, line 53-15, line 42. See also at least references to audit database, Fig. 3 and related text.

tracking the purchases made of products from the gateway by the customer. See, for example, references to purchase confirmation database, at least Fig. 2 and related text.

As per claims 1, 13 and 19, Shkedy **does not** use the term commerce portal. Shkedy refers to gateways and Internet. A portal is a web site that serves as a gateway to the Internet; a portal is a collection of links, content and services designed to guide

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users to information they are likely to find interesting.¹ Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Shkedy and knowledge generally available to disclose a commerce portal to provide procurement of products from vendors. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Shkedy and knowledge generally available to disclose a commerce portal to provide procurement of products from vendors for the obvious reason that by doing so, buyers may, through the principles of supply and demand, can command better leverage in negotiating better prices.

As per claim 2, Shkedy discloses that *nodes* is at least one of: (i) the *server*, and (ii) the *client*. See, for example, at least Col. 8, line 55-Col. 9, line 2.

As per claims 3 and 16, Shkedy discloses that products offered for sale are medical products. See, for example, at least Col. 27, lines 8-24.

As per claim 5, Shkedy discloses that a first product, of the products offered for sale, is from a first industry, and wherein a second product, of the products offered for sale is from a second industry. See, for example, at least Col. 13, lines 18-52.

As per claim 6, Shkedy discloses that a first computer device is a server. See, for example, at least Fig. 1 and related text.

As per claim 7, Shkedy discloses that a second computer device is a client. See, for example, at least Fig. 1 and related text.

¹ Definition of *portal*, MICROSOFT Computer Encyclopedia.

As per claim 8, Shkedy discloses that the network is the Internet. See, for example, at least Col. 1, line 14-Col. 2, line 9. see also at least Col. 2, lines 59-67.

As per claim 9, Shkedy discloses that products represented by the *PO* are purchased electronically through the gateway. See, for example, at least Col. 1, line2, lines 42-52.

As per claim 10, Shkedy discloses that the *server* is configured to selectively authorize access to the gateway. See, for example, at least Col. 4, line 60-Col. 5, line 20.

As per claim 11, Shkedy discloses that additional nodes (applicant's third computer) may analyze information obtained by tracking the purchasing of products from the gateway by the customer. See, for example, at least references to various nodes on the Internet and tracking, Col. 5, line 61-Col. 6, line 17.

As per claims 12 and 18, Shkedy discloses that additional nodes (applicant's third computer) may configured to provide a report that includes information obtained by tracking the purchasing of products from the gateway by the customer, wherein the report is provided to at least one of: (i) the customer; and (ii) a vendor. See, for example, at least Col. 4, line 48-59, concerning analysis by potential sellers.

As per claim 14, Shkedy discloses that providing a *portal* may be performed by one or more servers. See, for example, at least references to distributed environment, Col. 11, lines 42-63.

As per claim 15, Shkedy discloses that products offered for sale include products from a variety of different industries. See, for example, at least Col. 13, lines 18-52.

As per claim 17, Shkedy does not specifically disclose determining whether the purchasing order is authorized. See, for example, at least Col. 7, lines 43-47.

As per claim 20, Shkedy discloses executable code for implementing at least one of the steps for: (i) authorizing the **PO** relating to the **portal**; and (ii) providing a purchase analysis. See, for example, at least Col. 4, line 48-59, concerning analysis by potential sellers.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy (US 6,260,024) in view of DeBusk (US 5,991,728).

As per claim 4, Shkedy **does not** specifically disclose that medical products relate to performing a dialysis procedure. DeBusk discloses tracking supplies in health care environments and specifically refers to dialysis machines. See, for example, at least Col. 12, lines 28-52. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Shkedy and DeBusk to disclose commerce portals for medical products relating to dialysis procedures. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Shkedy and DeBusk to disclose commerce portals for medical products relating to dialysis procedures for the obvious reason that by including various types of machines, it is possible for buyers and sellers alike to determine if usage estimates for specific

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procedures are accurate and allow for more informed decisions concerning new equipment purchases.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

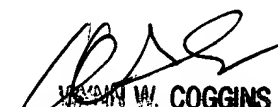
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JZ
James Zurita
Patent Examiner
Art Unit 3625
20 June 2005


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